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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/031,764	09/30/2002	Bansi Lal	HMR99L044/PCT/US	8326

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EXAMINER

AUDET, MAURY A

ART UNIT

PAPER NUMBER

1654

DATE MAILED: 04/01/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/031,764

Applicant(s)

LAL ET AL.

Examiner

Maury Audet

Art Unit

1654

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 30 September 2002.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-7, 9 and 10 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-7, 9 and 10 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 01/18/2002.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-7, and 9-10 are rejected under 35 U.S.C. 102(b) as being anticipated by Balkovec et al. I (US 5,378,804; also cited within Applicant's PCT/EP00/06769 Form 409 as Document 4 (D4), under it's WO continuity WO-A-9421677).

Balkovec et al. I teach cyclohexapeptides of formula I (see i.e. abstract) and formula IV (see i.e. Example 1), with secondary amine selected from i.e. dimethylamine (Examples 26-27; col. 29, lines 12-15, 49-51), as antifungals compositions (abstract), and methods of making the same (Examples, entire disclosure).

Claims 1-4, 6-7, and 9-10 are rejected under 35 U.S.C. 102(b) as being anticipated by Balkovec et al. II (US 5,541,160; also cited within Applicant's PCT/EP00/06769 Form 409 as Document 1 (D1), under it's WO continuity WO-A-9527074).

Balkovec et al. II teach cyclohexapeptides of formula I (see i.e. abstract) and formula IV (see i.e. col. 4, SEQ ID NO: 3), as antifungals compositions (col. 1, 1st para.), and methods of making the same (Examples, entire disclosure).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-7 and 9-10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Balkovec et al. II (US 5,541,160; also cited within Applicant's PCT/EP00/06769 Form 409 as Document 1 (D1), under its WO continuity WO-A-9527074), in view of Balkovec et al. I (US 5,378,804; also cited within Applicant's PCT/EP00/06769 Form 409 as Document 4 (D4), under its WO continuity WO-A-9421677).

The references are discussed above. Balkovec et al. II does not expressly teach a compound with a secondary amine of i.e. dimethylamine (Applicant's claim 5).

It would have been obvious to one of ordinary skill in the art at the time the claimed invention was made to use a secondary amine such as dimethylamine in the compounds of Balkovec et al. II, since Balkovec et al. I teach the advantageous use of secondary amines such as dimethylamine in the same family of cyclohexapeptides of Balkovec et al. II.

Claims 1-7 and 9-10 are rejected under 35 U.S.C. 103(a) as being unpatentable over either Balkovec et al. I (US 5,378,804; also cited within Applicant's PCT/EP00/06769 Form 409 as Document 4 (D4), under its WO continuity WO-A-9421677) or Balkovec et al. II (US 5,541,160; also cited within Applicant's PCT/EP00/06769 Form 409 as Document 1 (D1), under its WO continuity WO-A-9527074).

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The references are discussed above.

It would have been obvious to one of ordinary skill in the art at the time the claimed invention was made to use varying amounts of starting materials and/or steps to arrive at the variations in the cyclohexapeptides of Balkovec et al. I or II, since both references advantageously teach the same family of compounds with modifications and because arrival at such modifications is matter of judicious selection by one of skill in the art and a matter of routine optimization thereto, absent evidence to the contrary.

From the teachings of the reference, it is apparent that one of ordinary skill in the art would have had a reasonable expectation of success in producing the claimed invention. Therefore, the invention as a whole was prima facie obvious to one of ordinary skill in the art at the time the invention was made, as evidenced by the references, especially in the absence of evidence to the contrary.

Conclusion

No claims are allowed.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Maury Audet whose telephone number is 571-272-0960. The examiner can normally be reached from 7:00 AM – 5:30 PM, off Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Bruce Campell can be reached at 571-272-0974. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 571-272-1600.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197.

MA, 03/18/2005



CHRISTOPHER R. TATE
PRIMARY EXAMINER